Index of Claims	Application/Control No.	Applicant(s)/Patent Under Reexamination
	90007750	6233389
	Examiner	Art Unit
	Escalante, Ovidio	3992

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47

CLAIM		DATE								
Final	Original	11/01/2007								
1	1	=								
2	2	=								
3	3	=								
4	4	=								
5	5	=								
6	6	=								
7	7	=								
8	8	=								
9	9	=								
10	10	=								
11	11	=								
12	12	=								
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29	29	=								
30	30	=								
31	31	=								
32	32	=								
33	33	=								
34	34	=								
35	35	=								
36	36	=								

Index of Claims	Application/Control No.	Applicant(s)/Patent Under Reexamination
	90007750	6233389
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✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
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☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47

CLAIM		DATE								
Final	Original	11/01/2007								
37	37	=								
38	38	=								
39	39	=								
40	40	=								
41	41	=								
42	42	=								
43	43	=								
44	44	=								
45	45	=								
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58	58	=								
59	59	=								
60	60	=								
61	61	=								

Reexamination	Application/Control No.	Applicant(s)/Patent Under Reexamination
	90/007,750	6233389
	Certificate Date	Certificate Number
		C1

Requester Correspondence Address: ☐ **Patent Owner** ☒ **Third Party**

David L. Fehrman
MORRISON & FOERSTER LLP
555 W. Fifth Street, Suite 3000
Los Angeles, CA 90013

LITIGATION REVIEW ☒	**OE** (examiner initials)	**10/31/07** (date)
Case Name		Director Initials
Tivo, Inc v. Echostar Communications Corporation et al - US District - Georgia Northern (Atlanta) 1:05cv2799		MMcNeil for Lissi Mojica Morgis
Tivo Inc v. Echostar Comm, et al U.S. District - Texas Eastern (Marshall) - 2:04cv1		
Tivo Inc, v. Sonicblue Incorporated et al. U.S. District - California Northern (San Francisco) 3:02cv365		
Tivo, Inc v. Sonicblue Incorporated e tal. U.S. District Northern (Oakland) 4:02cv365		

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	**NUMBER**
1. No Concurrent Office Proceeding	
2.	
3.	
4.	

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,750	10/17/2005	6233389	2513.001REX0	4653

26111 7590 11/28/2007

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/28/2007

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DAVID L. FEHRMAN
MORRISON & FOERSTER, LLP
555 W. FIFTH STREET, SUITE 3500
LOS ANGELES, CA 90013

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007750
PATENT NO. 6,233,389
ART UNIT 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Notice of Intent to Issue Ex Parte Reexamination Certificate	Control No.	Patent Under Reexamination	
	90/007,750	6233389	
	Examiner	Art Unit	
	Ovidio Escalante	3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. ☒ Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. *Cf.* 37 CFR 1.313(a). A Certificate will be issued in view of
   (a) ☒ Patent owner's communication(s) filed: *29 October 2007*.
   (b) ☐ Patent owner's late response filed: _____.
   (c) ☐ Patent owner's failure to file an appropriate response to the Office action mailed: _____.
   (d) ☐ Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
   (e) ☐ Other: _____.

   Status of *Ex Parte* Reexamination:
   (f) Change in the Specification: ☐ Yes ☒ No
   (g) Change in the Drawing(s): ☐ Yes ☒ No
   (h) Status of the Claim(s):
      (1) Patent claim(s) confirmed: *1-61*.
      (2) Patent claim(s) amended (including dependent on amended claim(s)): _____
      (3) Patent claim(s) cancelled: _____.
      (4) Newly presented claim(s) patentable: _____.
      (5) Newly presented cancelled claims: _____.

2. ☒ Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."

3. ☐ Note attached NOTICE OF REFERENCES CITED (PTO-892).

4. ☐ Note attached LIST OF REFERENCES CITED (PTO/SB/08).

5. ☐ The drawing correction request filed on _____ is: ☐ approved ☐ disapproved.

6. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All b)☐ Some* c)☐ None of the certified copies have
   ☐ been received.
   ☐ not been received.
   ☐ been filed in Application No. _____.
   ☐ been filed in reexamination Control No. _____.
   ☐ been received by the International Bureau in PCT Application No. _____.

   * Certified copies not received: _____.

7. ☐ Note attached Examiner's Amendment.

8. ☒ Note attached Interview Summary (PTO-474).

9. ☐ Other: _____.

Ovidio Escalante
CRU Examiner
Art Unit: 3992

cc: Requester (if third party requester)

DETAILED ACTION

1. This action is in response to the Patent Owner's response filed on October 29, 2007. Claims 1-61 are pending in the present *exparte* reexamination proceeding.

Status of the Claims

2. Original claims 1-61 are confirmed.

STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:

Regarding claims 1 and 32:

U.S. Patent 6,788,882 to Geer et al.

The claim requires *inter alia* providing "...at least one Input Section, wherein said Input Section converts said specific program to an Moving Pictures Expert Group (MPEG) formatted stream for internal transfer and manipulation; providing a Media Switch, wherein said Media Switch parses said MPEG stream, said MPEG stream is separated into its video and audio components; storing said video and output components on a storage device...wherein said Output Section extracts said video and audio components from said storage device..."

The Geer Patent discloses the use of a computerized content search feature that automatically catalogs audio content digitally. According to Geer, the process utilizes the audio portion of the broadcast signal. As described in col. 4, lines 10-15, Geer describes the broadcast

signal to be in the form of (1) NTSC analog TV, (2) PAL/SECAM analog TV, (3) digital TV, (4) analog HDTV and (5) HDTV. Geer also discloses in col. 6, lines 14-25 that the broadcast signal can be received in compressed form such as MPEG II.

With the uncompressed broadcast signal, Geer performs content-based analysis prior to compression to MPEG II. After the analysis is performed, the analyzed data component will be stored as compressed MPEG II form and subsequently outputted after being decompressed. Since the claims require, converting the broadcast signal to MPEG format, then parsing the MPEG stream into its video and audio components and then storing said video and output components, then it is clear that Geer fails to disclose of the above steps when receiving an uncompressed broadcast signal since Geer does not disclose an uncompressed signal being converted to MPEG and then subsequently being parsed into its audio and video components prior to having the audio and video components stored.

However, the Examiner notes that Geer discloses that the content analysis is performed to a broadcast signal and since MPEG II is one of the possible broadcast signals then, as known in the art, the MPEG II stream will inherently be decompressed prior to being analyzed and stored. Geer discloses of parsing the MPEG II stream to extract the audio component and performing a content analysis on the audio component.

Geer also separately discloses that for stored MPEG II compressed video, the output is first sent to the decompression device such as a MPEG decoder when the stream is going to be outputted to the television set.

The Examiner acknowledges that Geer does not specifically disclose of decompressing the received MPEG II stream for analysis but argued that it is inherent that Geer performs this

because "it is impossible to analyze the audio portion of a MPEG data stream without decompressing it first". The Examiner also previously noted that decompression requires a demultiplexer for parsing and separating at least the audio component from the stream so that it can be decompressed.

Thus, the Examiner noted that Geer discloses either through inherency or obviousness of parsing the MPEG stream into at least its audio component (video is parsed based on disclosure of Cobbley). The Examiner also noted that Geer further discloses of storing the received MPEG II stream and outputting the MPEG stream as TV signals after going through a decoder.

Geer fails to disclose after parsing the MPEG stream and obtaining the audio component, that the same audio component (which resulted from the parsing) is stored and that the **same** audio component that was obtained from the parsing is sent to a decoder for converting it to a TV signal.

As stated by the Patent Owner in the response received on October 29, 2007:

"[I]ndependent claims 1 and 32 require the system to accept "TV broadcast signals" and tune "to a specific program." The system also "converts said specific program to an ... MPEG formatted stream for internal transfer and manipulation." The system "parses said MPEG stream, said MPEG stream is separated into its video and audio components." This is the first mention of "video and audio components." These *same* video and audio components are stored on a storage device and also extracted for playback. **In other words, the "MPEG stream is separated into its video and audio components," and both the storing and extracting must be of these *same "said* video and audio components." These *"said* video and audio components" are**

also assembled into an MPEG stream which is sent to a decoder for conversion into TV output signals," (underlining and bolding inserted by Examiner).

Thus, it is clear that the audio and video components which resulted from the parsed MPEG stream is the same audio and video components which are stored and are subsequently the same audio and video components that are sent to the decoder for conversion to TV signals.

While Geer discloses the storing at least the audio component of the stored audio stream and that it was well known to decompress MPEG streams prior to being outputted, there is no disclosure or reason for the audio component to be compressed back to compressed MPEG form in order to be decompressed again for output in view of at least the disclosure of Geer.

The Patent Owner argued that the content-based analysis in Geer, if performed, must be performed either in Geer's input - prior to compression - or in Geer's output - after decompression by the decoder for output of the decompresses signal to the television. The Patent Owner further states that after the content-based analysis, Geer stores the indexed text of the uncompressed audio and thus does not teach or even suggest a *compressed (MPEG) stream* that is separated into its video and audio components and storing these same compressed *MPEG video and audio components* as required.

The Examiner agrees that for uncompressed input the content analysis is performed before compression, thus the claims are confirmed over this disclosure. However, the Examiner disagrees that compressed inputs (such as MPEG II) is performed prior to being outputted. The Examiner notes that this step in Geer is performed prior to any consideration of the MPEG stream being "outputted" since the audio component must be stored after the analyzing step thus prior to the outputting step. Nonetheless, as stated above, Geer fails to disclose at least providing

a Media Switch, wherein said Media Switch parses said MPEG stream, said MPEG stream is separated into its video and audio component; storing *said* video and audio components on a storage device; providing at least one Output Section, wherein said Output Section extracts *said* video and audio components from said storage device," since there is no disclosure in Geer of having the audio and video components which resulted from the parsing of the MPEG stream being stored and having that same audio and video components being decoded and converted to TV output signals.

Thus, the Examiner will not maintain the rejection under Geer for the above reasons and confirms the claims as originally filed.

U.S. Patent 5,614,940 to Cobbley et al.

As stated in the office action mailed on May 25, 2006 "[w]hat is missing from the Cobbley et al. showing, with respect to the claimed subject matter, is any teaching or suggestion of the "parsing" an MPEG data stream by a "Media Switch," wherein the MPEG data stream is "separated" into "its" audio and video components [i.e., as recited in the context of the independent claims 1 and 32]. That is, even when deriving the index information locally (e.g., @ 112), it seems that the content-based analysis would be performed on the received TV programming, e.g., in digital format, prior to MPEG compression [note lines 16-23 of column 6]. That is, it seems unlikely that one would receive a digital TV signal, compress the digital TV signal into an MPEG data stream, and then decompress the MPEG data stream back into its digital format for analysis (e.g., "parsing"). It would make more sense to perform the analysis/"parsing" of the TV signal prior to MPEG compression thereby avoiding the need for,

and expense of, an MPEG decoder. In any event, motivation for such an implementation/ modification of the Cobbley et al. system appears to be absent from the record.

Regarding claims 3-5,15-18 and 20-25:

The claims are confirmed based upon its dependency on confirmed independent claim 1.

Regarding claims 34-36,46-49 and 51-55:

The claims are confirmed based upon its dependency on confirmed independent claim 32.

As set forth in the final rejection:

Regarding claim 2:

The prior art of record does not show or suggest an "Input Section" as set forth in claim 1 wherein said input section directs the MPEG stream to the destination indicated by control commands, as recited in claim 2.

Regarding claim 6:

The prior art of record does not show or suggest a "Media Switch" as set forth in claim 1 wherein said Media Switch calculates and associates a time stamp to the audio and video components as is recited in claim 6.

Regarding claim 7:

The prior art of record does not show or suggest a "Media Switch" as set forth in claim 1 wherein said Media Switch logically associates received time stamp values with the audio and video components as is recited in claim 7.

Regarding claim 8:

The prior art of record does not show or suggest the "posting" of an event in a circular event file indicative of the location of a video component in a circular video buffer as set forth in claim 8.

Regarding claim 9:

The prior art of record does not show or suggest the "posting" of an event in a circular event file indicative of the location of a audio component in a circular video buffer as set forth in claim 9.

Regarding claims 10 and 11:

Claims 10 and 11 depend from claims 8 and 9 and avoid the art of record at least for the reasons expressed above for those claims.

Regarding claim 12:

The prior art of record does not show or suggest a method as recited in claim 1 in which the rate of the decoder system clock is increased for fast playback as is recited in claim 12.

Regarding claim 13:

The prior art of record does not show or suggest a method as recited in claim 1 in which the rate of the decoder system clock is decreased for slow playback as is recited in claim 13.

Regarding claim 14:

The prior art of record does not show or suggest a method as recited in claim 1 in which audio cues and on-screen displays are combined with the TV output signals as is recited in claim 14.

Regarding claim 19:

The prior art of record does not show or suggest a method as recited in claim 1 in the Media switch shares and address bus with the CPU.

Regarding claim 26:

The prior art of record does not show or suggest a method as recited in claim 24 in the user set time schedules the times during which stored programming is provided to an external recording device.

Regarding claim 27:

The prior art of record does not show or suggest a method as recited in claim 24 in a tile page is set to the external recording device.

Regarding claim 28:

The prior art of record does not show or suggest a method as recited in claim 24 in which the program is sped up to fit within the limited time available on the recording medium.

Regarding claim 29:

The prior art of record does not show or suggest a method as recited in claim 24 in which frames of the programming are dropped to permit it to fit within the limited time available on the recording medium.

Regarding claim 30:

The prior art of record does not show or suggest a method as recited in claim 24 in which the output of the recording device is provided back to the input section.

Regarding claim 33:

The prior art of record does not show or suggest an "Input Section" as set forth in claim 32 wherein said input section directs the MPEG stream to the destination indicated by control commands, as recited in claim 33.

Regarding claim 37:

The prior art of record does not show or suggest a "Media Switch" as set forth in claim 32 wherein said Media Switch itself calculates and associates a time stamp to the audio and video components as is recited in claim 37. The Examiner notes that the time stamps are associated with the files in Geer et al., however, not by the "media switch" (e.g. note lines 21-31 of col. 13).

Regarding claim 38:

The prior art of record does not show or suggest a "Media Switch" as set forth in claim 32 wherein said Media Switch itself logically associates received time stamp values with the audio and video components as is recited in claim 38. The Examiner notes that the time stamps are associated with the files in Geer et al., however, not by the "media switch" (e.g. note lines 21-31 of col. 13).

Regarding claim 39:

The prior art of record does not show or suggest the "posting" of an event in a circular event file indicative of the location of a video component in a circular video buffer as set forth in claim 39.

Regarding claim 40:

The prior art of record does not show or suggest the "posting" of an event in a circular event file indicative of the location of a audio component in a circular video buffer as set forth in claim 40.

Regarding claims 41 and 42:

Claims 41 and 42 depend from claims 39 and 40 and avoid the art of record at least for the reasons expressed above for those claims.

Regarding claim 43:

The prior art of record does not show or suggest an apparatus as recited in claim 32 in which the rate of the decoder system clock is increased for fast playback as is recited in claim 43.

Regarding claim 44:

The prior art of record does not show or suggest an apparatus as recited in claim 32 in which the rate of the decoder system clock is decreased for slow playback as is recited in claim 44.

Regarding claim 45:

The prior art of record does not show or suggest a method as recited in claim 32 in which audio cues and on-screen displays are combined with the TV output signals as is recited in claim 45.

Regarding claim 50:

The prior art of record does not show or suggest a method as recited in claim 32 in the media switch shares and address bus with the CPU.

Regarding claim 56:

The prior art of record does not show or suggest a method as recited in claim 54 in the user set time schedules the times during which stored programming is provided to an external recording device.

Regarding claim 57:

The prior art of record does not show or suggest a method as recited in claim 54 in a tile page is set to the external recording device.

Regarding claim 58:

The prior art of record does not show or suggest a method as recited in claim 54 in which the program is sped up to fit within the limited time available on the recording medium.

Regarding claim 59:

The prior art of record does not show or suggest a method as recited in claim 54 in which frames of the programming are dropped to permit it to fit within the limited time available on the recording medium.

Regarding claim 60:

The prior art of record does not show or suggest a method as recited in claim 54 in which the output of the recording device is provided back to the input section.

Regarding claims 31 and 61:

The prior art of record does not show or suggest an object-based method/apparatus that is recited in claims 31 and 61.

Any comments considered necessary by PATENT OWNER regarding the above statement must be submitted promptly to avoid processing delays. Such submission by the patent owner should be labeled: "Comments on Statement of Reasons for Patentability and/or Confirmation" and will be placed in the reexamination file.

Conclusion

NOTICE RE PATENT OWNER'S CORRESPONDENCE ADDRESS

Effective May 16, 2007, 37 CFR 1.33(c) has been revised to provide that:

The patent owner's correspondence address for all communications in an *ex parte* reexamination or an *inter partes* reexamination is designated as the correspondence address of the patent.

> *Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination*, 72 FR 18892 (April 16, 2007)(Final Rule)

The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to 37 CFR 1.33(c), automatically changed to that of the patent file as of the effective date.

This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, including the present reexamination proceeding, and to any reexamination proceeding which is filed after that date.

Parties are to take this change into account when filing papers, and direct communications accordingly.

In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

Telephone Numbers for reexamination inquiries:

Reexamination and Amendment Practice	(571) 272-7703
Central Reexam Unit (CRU)	(571) 272-7705

Reexamination Facsimile Transmission No. (571) 273-9900

3. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 6,233,389 throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

4. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

5. All correspondence related to this *ex parte* reexamination proceeding should be directed as follows:

Please MAIL any communications to:

Attn: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Please FAX any communication to:

(571) 273-9900
Central Reexamination Unit

Please HAND-DELIVER any communications to:

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

6. Any inquiry by the patent owner concerning this communication or earlier communications from the Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Ovidio Escalante

Ovidio Escalante
Primary Examiner
Central Reexamination Unit - Art Unit 3992
(571) 272-7537

Conferee:

David Harvey

Conferee:

Mark Reinhart

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT